



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of : **Confirmation No. 7425**
Peter HEROLD et al. : Attorney Docket No. 2006_0446A
Serial No. 10/574,108 : Group Art Unit 1624
Filed March 31, 2006 : Examiner Kahsay Habte
ORGANIC COMPOUNDS : **Mail Stop: Petitions**

PETITION TO DIRECTOR FROM RESTRICTION REQUIREMENT

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

THE COMMISSIONER IS AUTHORIZED
TO CHARGE ANY DEFICIENCY IN THE
FEE FOR THIS PAPER TO DEPOSIT
ACCOUNT NO. 23-0975.

Sir:

Under the provisions of 37 CFR 1.144, Applicants hereby petition the Director to review the requirement for restriction set forth in the Office Action of April 27, 2009, wherein the Examiner requires that Applicants amend the definition of R¹ to [1,4]benzoxazine.

Preliminary Remarks

Initially, as indicated in the Response to the Office Action filed concurrently herewith, Applicants' attorney discussed this restriction requirement with the Examiner by telephone. Applicants' attorney indicated that the restriction requirement set forth in the Office Action of April 27, 2009 constituted a restriction requirement beyond that set forth in the earlier Office Action of September 19, 2008, without giving Applicants an opportunity to argue against the further restriction requirement set forth in the Office Action of April 27, 2009. The Examiner stated that Applicants could file a petition from the restriction requirement. It is the understanding of Applicants' attorney, based on the telephone discussion with the Examiner, that

it would have been fruitless to further attempt to persuade the Examiner to withdraw the restriction requirement in the Office Action of April 27, 2009.

Statement of Facts

The present application is a U.S. National Phase application of International Application No. PCT/EP2004/052389 filed September 30, 2004, claiming priority from two Swiss applications, the first of which was filed October 1, 2003. On March 31, 2006, Applicants filed papers requesting national examination procedures. A Notice of Acceptance under 35 U.S.C. §371 and 37 CFR 1.495, as well as an Official Filing Receipt, were mailed October 4, 2006. A Preliminary Amendment was filed February 4, 2008, replacing original claims 1-10 with new claims 11-22.

In the Office Action dated September 19, 2008 the Examiner issued a restriction requirement, whereby election between sections (A) to (F) in claim 11 (main claim) was required. The Examiner indicated that "further restriction maybe required", and he also required election of a single disclosed species.

In Applicants' response of October 20, 2008 to the restriction requirement, with traverse, they selected group (A), where R¹ is a heterocyclyl group. As a single specific species Applicants elected Example 5, namely:

6-(4-{4-[3-(2-Methoxy-benzyloxy)-propoxy]-phenyl}-piperidin-3-yloxymethyl)-4-(3-methoxy-propyl)-3,4-dihydro-2H-**benzo[1,4]oxazine**, which falls under "dihydro-2H-benzo[1,4]oxazinyl", to be found bridging lines 4 and 5 under the definition of the group (A) in claim 11.

In the Office Action of December 5, 2008, the Examiner considered the restriction requirement to still be proper, rejected Applicants' arguments for traverse, and made the restriction requirement final.

In Applicants' response filed April 6, 2009, they restricted the definition of R¹ to section (A) of claim 11, i.e. all of sections (B)-(F) for the definition of R¹ were deleted from claim 11.

In the current Office Action, mailed April 27, 2009, in item 3 on page 2, the Examiner requires that Applicants amend the definition of R¹ to [1,4]benzoxazine. It is this requirement from which Applicants petition.

Points to be Reviewed

Whether it was proper for the Examiner, in the Office Action of April 27, 2009, to require that Applicants amend the definition of R¹ to [1,4]benzoxazine (or file a petition from the restriction requirement).

Action Requested

Applicants petition the Director to direct the Examiner to withdraw the requirement that Applicants amend the definition of R¹ to [1,4]benzoxazine.

Applicants' Arguments in Support of the Requested Action

As noted in MPEP 1893.03(d), examiners are reminded that unity of invention (not restriction practice) is applicable in international applications and in national stage applications submitted under 35 U.S.C. §371. This MPEP section also refers to PCT Rule 13, which establishes the requirements for unity of invention. PCT Rule 13 is embodied in 37 CFR 1.475, which like PCT Rule 13, states that the requirement of unity of invention shall be fulfilled only when there is a technical relationship among the inventions involving one or more of the same or corresponding "special technical features", meaning those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art.

As stated in MPEP 1893.03(d), when making a lack of unity of invention requirement, the examiner **must** (1) list the different groups of claims and (2) explain why each group lacks unity with each other group (i.e., why there is no single general inventive concept) specifically describing the unique special technical feature in each group. The Examiner has not complied with this requirement, in requiring that R¹ in the presently claimed compounds be limited to

[1,4]benzoxazine. As indicated above, 37 CFR 1.475 defines "special technical features" as meaning those technical features that define a contribution which each of the claimed inventions considered as a whole, makes over the prior art. The Examiner has failed to explain why there is no technical relationship among the presently claimed compounds involving one or more of the same or corresponding special technical features. In this regard, Applicants note that the Examiner has not cited any prior art in support of lack of unity of invention (nor has there been any prior art rejection against the claims).

Conclusion

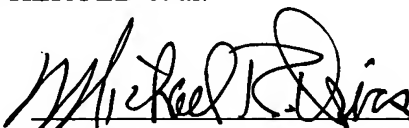
The Examiner has failed to establish a lack of unity of invention, and accordingly, the requirement that Applicants amend the definition of R¹ to [1,4]benzoxazine in the Office Action of April 27, 2009 is improper. Accordingly, Applicants request that the Examiner be directed to withdraw this requirement.

The Commissioner is authorized to charge any deficiency or to credit any overpayment associated with this communication to Deposit Account No. 23-0975, with the EXCEPTION of deficiencies in fees for multiple dependent claims in new applications.

Respectfully submitted,

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